

REMARKS/ARGUMENTS

In the above-mentioned Office Action: Claims 231-250, 256, 257, 263, 283-296, and 303-326 were rejected under Section 112, first paragraph; claims 232, 235 and 236, were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; claims 231, 232, 242-244, 248, 249 and 291-294, were rejected as being anticipated by U.S. Patent 5,951,819 (Hummell); claims 231 and 241 were rejected as being anticipated by U.S. Patent 6,508,914 (Schwaller); claims 231-234, 237-240, 242-244, 291 and 327 were rejected as being anticipated by U.S. Patent 6,660,113 (Hummell et al.); claims 250-255, 258-262, 271, 273-282 and 297-301 were allowed; and claims 245, 256, 257, 295 and 346-350 were found to be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2nd paragraph and to include all of the limitations of the base claim and any intervening claims.

Claims 325-362 have been renumbered 324-361.

The allowance of claims 250-255, 258-262, 271, 273-282, and 297-301 is acknowledged with appreciation; and these claims remain in the application.

Amended independent claim 345 is in condition for allowance in view of the allowability of dependent claims 346-350.

In response to the Section 112, first paragraph rejections, in paragraph 4 and other paragraphs, there are numerous well described and illustrated apparatuses which have alternative small hole label and large hole label modes disclosed in the subject application. See paragraph 5 which mentions large hole labels and guide structure. Additionally, it is settled law that the drawings are to be consulted in a Section 112, first paragraph analysis, and in fact the drawings can be the entire basis. See *Vas-Cath v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed.Cir. 1991) ("Drawings alone may provide a "written description" of an invention as required by § 112.")

As examples: (1) elements 324, 330 and 320, FIG. 7, and paragraphs 136 and 137; (2) elements 474 and 476, FIGS. 58-61, and paragraph 158; (3) elements 466 and 404, FIGS. 88, 90 and 93, and paragraphs 169-171; (4) elements 408, 420, 528, 526

and 418, FIGS. 95-101, and paragraph 172; and (5) FIG. 112 shows in isolation a post assembly, which is positionable in a lower portion (for a small hole label) or a raised portion (see, e.g., FIG. 100) for a large hole label.

Allowable claims 245, 256 and 295 have been rewritten as new independent claims 362, 363 and 365, respectively. They are thus in condition for allowance.

Dependent claims 366-372 have been added.

The Examiner has taken the position that the claim language following the descriptive phrase "adapted to" is not a structural limitation. Applicants respectfully submit that the Examiner's position is incorrect as a matter of law and that language in the body of a claim following the descriptive phrase "adapted to" is in fact a structural limitation. For example, in *In re Venezia*, 189 USPQ 149 (CCPA 1976), some of the claim language at issue was "a pair of elastic sleeves ... adapted to be fitted over the insulating jacket of one of said cables." *Id.* at 150. Concerning the above-quoted aspect of the claim, the CCPA stated that: "rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is constructed or dimensioned that it can be fitted over the insulating jacket of the cable." *Id.* at 151-152, emphasis added.

It is also well settled that all limitations must be considered and it is improper to ignore specific limitations in a claim that distinguish over the cited references. See, e.g., *In re Boe & Duke*, 184 USPQ 38, 40 (CCPA 1974).

Accordingly, Applicants respectfully submit that the portions of the claims that follow the descriptive phrase "adapted to" are positive structural limitations that must be afforded the same weight as any other limitations recited in the body of a claim.

Neither Hummell '819 or '113 nor Schwaller teaches a label applicator having two modes (e.g., operative and unoperative positions) – first for centering a first label having a narrow central opening and a second for centering a second label having a wide central opening, as claimed in claims 231 and 248. Examples of these labels are discussed in paragraph 133, and examples of hole diameters are set forth in paragraph 142.

Claim 231 has been amended to more clearly define over the prior art including Hummell and Schwaller.

Referring to independent claim 283, as an example only, FIG. 1 shows a small hole label in place; FIG. 7 shows a large hole label in place with left post 340 lifted relative to post assembly 12 and locator member 324 extending up above the support surface.

Referring to claim 303, as an example only, FIG. 7 shows a locator assembly in the second position and FIG. 1 shows it in the first position.

Referring to independent claim 315, as an example only, FIG. 58 shows a ring 460, a post 462 and a spindle 406; and FIG. 62 shows a ring 460, a post 462 and a spindle 444.

Claim 232 has been amended to clarify it.

The circles of claims 235 and 236 can be understood from FIGS. 1 and 7 since they correspond with the circles defined by the small and large holes of the labels.

Claim 327 has been amended to positively recite the coil spring and thereby define over the prior art.

An anticipation rejection requires that the Examiner show where each and every claim element is located in the prior art reference. The Examiner has not made that showing in her rejections, Applicants respectfully contend. Specifically, MPEP Section 2131 provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 1053 (Fed.Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed.Cir. 1989). The elements must be arranged as required by the claim..."

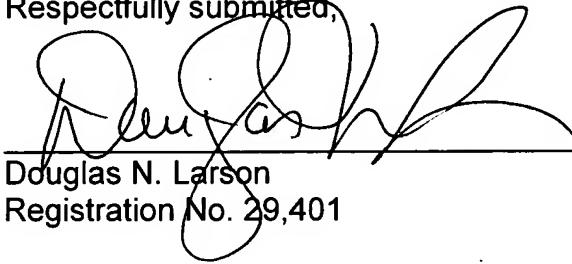
The cited references alone or in combination fail to teach or suggest all of the claim limitations. For many of the claim elements the Examiner has simply stated that the reference relates to a label construction which comprises the elements without

pointing out specifically where the reference shows (such as by reference numeral) each of the elements.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call Applicants' undersigned counsel at (213) 689-5142 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1853. Should such additional fees be associated with an extension of time, Applicants respectfully request that this paper be considered a petition therefor.

Respectfully submitted,


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